

REMARKS

Summary of the Office Action

In the Office Action, the Office:

- Objected to the drawings as not showing every feature of the invention described in the claims;
- Rejected Claims 26-29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, namely, the limitation of a “surgical saw”;
- Rejected Claims 1, 8, 9, 15-17, 24, 25, 26 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104);
- Rejected Claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Yamanaka (U.S. Patent No. 4,825,714);
- Rejected Claims 5-7 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Zufle (U.S. Patent Application Publication No. 2003/0109953);
- Rejected Claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Zimmerman (U.S. Patent No. 6,494,005); and,
- Rejected Claims 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Ghodoussi (U.S. Publication No. 2003/0144649).

By this Reply, Claims 26-29 are cancelled. Accordingly, Claims 1, 3, 5-10, 15-18, 24 and 25 are at issue. In view of the following Remarks, Applicant submits that the Application is now in condition for allowance and requests same.

Objection to the Drawings and Rejections under 35 U.S.C. § 112

The Office objected to the drawings based on limitations in Claims 26-29 and rejected Claims 26-29 under 35 U.S.C. § 112, first paragraph. Applicant has cancelled Claims 26-29 in response.

Swearing Behind Publication Date of Harris

The Office rejected Claims 1, 3, 5-10, 15-18, 24 and 25 based primarily on Harris (WO 02/060653). Applicant respectfully submits that Harris is not prior art to the present Application.

Harris has a publication date of August 8, 2002 and qualified as prior art based on that date (the present Application having an earliest priority date of September 3, 2002). Applicant submits the attached Inventor's Declaration under 37 C.F.R. § 1.131 to swear behind the August 8, 2002 publication date, establishing a date of invention and actual reduction to practice prior to August 8, 2002 and eliminating Harris as prior art under 35 U.S.C. § 102(a).

To the extent, the actual reduction to practice is not established by the Inventor's Declaration, Applicant further attaches the Assignee's Declaration to establish diligence to reduction to practice from a time prior to August 8, 2002, and continuing until no later than September 3, 2002 (the priority date of the present Application). The inventor with aid from the predecessor assignee diligently attempted to reduce the invention to practice by, among other things:

- (a) reviewing the invention with the predecessor assignee;
- (b) engaging an attorney to prepare a patent application covering the invention;
- (c) receiving at least one draft of the patent application;
- (d) reviewing and commenting on at least one draft of the patent application covering the claimed invention; and
- (e) filing the priority application in the UK on September 3, 2002, demonstrating at the very least a constructive reduction to practice.

In view of the foregoing, Applicant respectfully submits that a date of invention prior to August 8, 2002 has been successfully established.

Statement of Common Ownership of Harris

Harris might still qualify as prior art as of its international filing date of January 29, 2002 under 35 U.S.C. § 102(e). However, under 35 U.S.C. § 103(c), Harris is disqualified as prior art to Claims 1, 3, 5-10, 15-18, 24 and 25 because the present application, Application Serial No. 10/526,258, and Harris were, at the time the invention of Application Serial No. 10/526,258 was made, owned by The Acrobot Company Limited, predecessor to the current assignee, Stanmore Implants Worldwide Limited.

Therefore, Harris is not prior art to the present Application.

Conclusion

As a result of the above Amendments and Remarks, Applicant respectfully submits that the Application is in condition for allowance. If any deficiencies remain, the Office is invited to telephone the undersigned to facilitate allowance of the claims.

Respectfully submitted,

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